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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,254	08/17/2005	Gerhard Eidenhammer	2005_1013A	8670
513 7590 06/03/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER STONE, CHRISTOPHER R				
ART UNIT		PAPER NUMBER		
1614				
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06/03/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/540,254

Applicant(s)

EIDENHAMMER ET AL.

Examiner

CHRISTOPHER R. STONE

Art Unit

1614

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-21 is/are pending in the application.
- 4a) Of the above claim(s) 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-18, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Applicants' arguments, filed March 5, 2008, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11-18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nikolayev et al (US Patent 5925776)

Claims 11-18, 20 and 21 are drawn to a method of producing a stable formulation of an antineoplastic agent, comprising treating a formulation of the antineoplastic agent and solvent or solvent system with a cation exchanger. Paclitaxel and polyoxyethylene castor oil/ethanol are the elected species of antineoplastic and solvent system under examination.

Nikolayev et al describes a method of producing a stable formulation of paclitaxel, comprising treating polyoxyethylene castor oil with Dowex 650c, a cation exchanger that contains sulfonic acid groups, and then dissolving paclitaxel to 6mg/ml in an approximately 50:50 mixture of the purified polyoxyethylene castor oil and ethanol (Column 6, example I and column 8, example VI). Nikolayev does not describe combining paclitaxel, polyethylene castor oil and ethanol and then treating the mixture with the ion exchanger.

Treating the polyoxyethylene castor oil with a cation exchanger before or after the addition of paclitaxel and ethanol would have been obvious to one of ordinary skill in the art at the time of the invention because either order accomplishes the same goal of removing cations, which cause instability in the formulation, from the polyoxyethylene castor oil. Applicant is reminded of *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946), which affirms that the selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results.

Furthermore the optimization of the amount of cation exchanger used in the treatment of the polyoxyethylene castor oil and ethanol in the solvent system would have been obvious to one of ordinary skill in the art at the time of the invention as well.

Optimizing the cation exchanger amount would have been desired for maximal cation removal using as little exchanger as possible. Optimization of the ethanol amount would have been desired to achieve optimal stability of paclitaxel. This routine experimentation is common in the pharmaceutical art. Applicant is reminded of *in re Aller* which affirmed that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Applicant argues that the instantly claimed method results in unexpected better storage (i.e. less decomposition of the paclitaxel in the solution), as demonstrated by the comparative example submitted in the reply filed March 5, 2008. This is found unpersuasive because it is uncertain that the difference in the decrease in paclitaxel content after storage (a difference of 0.12% between the instantly claimed method and prior art) and the difference in overall contamination (a difference of 0.3% between the instantly claimed method and prior art) is statistically significant. The Applicant has not provided the error for the measurements, the initial concentrations of paclitaxel is well over 100% in each case (greater than 5.0%) and the overall contamination appears to decrease after storage in the example using the instantly claimed method. Applicant is reminded of *Ex parte Gelles*, which affirmed that evidence used overcome a rejection under 35 USC § 103 should establish "that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance." *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992) The comparative example, submitted in the reply filed March 5, 2008, fails to do so for the aforementioned reasons.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER R. STONE whose telephone number is (571)270-3494. The examiner can normally be reached on Monday-Thursday, 7:30am-4:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

29May2008

CRS

/Ardin Marschel/

Supervisory Patent Examiner, Art Unit 1614